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JUL 10 2007

OFFICE OF PETITIONS

In re Application of :
Janice Richardson :
Application No. 09/955,778 : **ON PETITION**
Filed: 09/18/2001 :
Atty Dckt No. RI118/000RI :

This is a decision on the petition filed on 30 May, 2007, under 37 CFR 1.137(a),¹ to revive the above-identified application, which is first treated as a petition to withdraw the holding of abandonment.

The petition is **dismissed**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)" or "Renewed Petition to withdraw the holding of abandonment," or as discussed below "Renewed Petition under 37 CFR 1.137(b)."

The application became abandoned on 5 June, 2003, for failure to timely submit the issue fee as required by the Notice of

¹ A grantable petition under 37 CFR 1.137(a) must be accompanied by:

(1) the required reply, unless previously filed; In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) the petition fee as set forth in 37 CFR 1.17(l);

(3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

Allowance and Fee(s) Due and corrected drawings as required by the Notice of Allowability, both mailed on 4 March, 2003, which set a three (3) month statutory period for reply. Notice of Abandonment was mailed on 4 August, 2003.

Petitioner asserts unavoidable delay in that her former patent attorney, Joseph N. Breaux, did not inform her that the issue fee was due and that petitioner subsequently learned that Breaux "was no longer licensed to practice law in the State of Louisiana and ... could no longer continue to represent me before the U.S. Patent and Trademark Office."

Specifically, petitioner states, in pertinent part:

5. I did not hear from Mr. Breaux's office again until June 2003. In a letter dated June 27, 2003, Linda Alleman (an assistant to Mr. Breaux) informed me that she had requested a copy of the Official Filing Receipt from the U.S. Patent and Trademark Office, and that she would forward a copy of such receipt to me. This was the last correspondence I received from Mr. Breaux's office.

6. In March 2004, William David Kiesel of Roy, Kiesel, Keegan & DeNicola of Baton Rouge, Louisiana, notified me that Mr. Breaux was no longer licensed to practice law in the State of Louisiana and that he could not continue to represent me before the U.S. Patent and Trademark Office. Mr. Kiesel informed me that he was the court-appointed curator of my file, but had not reviewed my file. He offered to provide me a complete copy of the file upon request. I immediately requested my file, which was sent to me on April 5, 2004.

7. I immediately reviewed my file. Nothing in the file indicated that there were any outstanding actions that required response. Specifically, the file did not contain any information regarding the NOTICE OF ALLOWANCE or the NOTICE OF ABANDONMENT, which I subsequently discovered had been mailed to Mr. Breaux in 2003.

8. In May, 2007, I contacted David Nagle, a registered patent attorney with Stites & Harbison, PLLC, of Louisville, Kentucky. He promptly obtained a copy of the complete prosecution history from the U.S. Patent and Trademark Office. Mr. Nagle informed me that a

NOTICE OF ALLOWANCE had been mailed from the U.S. Patent and Trademark Office on 3/04/03, and that a NOTICE OF ABANDONMENT had been mailed on 8/04/03. As stated above, Mr. Breaux's file did not contain either document or any indication that either document had been received by Mr. Breaux's office or responded to in any fashion. Furthermore, the request by Mr. Breaux's assistant for the Official Filing Receipt almost two years after the application was filed is unusual and suggests a possible breakdown in the mailing and receipt of communications regarding my patent application between the U.S. Patent and Trademark Office and Mr. Breaux's office.

PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

Petitioner asserts that the Notice of Allowance and Fee(s) Due and the Notice of Allowability (hereinafter referred to collectively as "the Notices") mailed on 4 March, 2003, were never received. A review of the record indicates no irregularity in the mailing of the Notices, and in the absence of any irregularity in the mailing, there is a strong presumption that the Notices were properly mailed to the address of record. This presumption may be overcome by a showing that the Notices were not in fact received. The showing required to establish the failure to receive an Office action must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement.² The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office communication may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

A review of the record shows that Breaux was presumably representing petitioner and prosecuting the application as of 4 March, 2003, the date the Notices were mailed. Breaux's address was the address of record. Additionally, the power of attorney filed with the application papers appointed Breax as the sole

² M.P.E.P. § 711.03(c); See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

attorney of record. Furthermore, the letter of June 27, 2003, referenced by petitioner suggests that Breaux was prosecuting the application. As such, any allegation that the Notices were not received must be supported by a showing that they were not received at the address of record, in this case, Breaux's address of Suite A, 10630 N. Oak Pkwy, Baton Rouge, LA 70810.

Petitioner would therefore need to contact Breaux and obtain a copy of the records, and the statement from the practitioner, as referenced above in order to show that the Notices were not received by Breaux at the correspondence address of record at the time the Notices were mailed. If petitioner cannot provide such documentation, petitioner will not be able to show that the Notices were not received.

The showing of record is insufficient at this time is insufficient to show that the Notices mailed on 4 March, 2003, were not received. Accordingly, the petition to withdraw the holding of abandonment must be dismissed.

PETITION UNDER 37 CFR 1.137(a)

The petition lacks the reply required by 37 CFR 1.137(a)(1). The petition is dismissed because petitioner failed to submit corrected drawings. The Notice of Allowability, mailed on 4 March, 2003, concurrently with the Notice of Allowance and Fee(s) Due, set forth a statutory period of three months from the mailing date in which petitioner was required to submit corrected drawings. Thus, the Notice of Allowability and the Notice of Allowance set forth concurrent but distinct requirements with which petitioner was required to comply. Accordingly, pursuant to the provisions of 37 CFR 1.137(b)(1) and in accordance with 35 U.S.C. §§ 133 and 151, the submission of corrected drawings is a necessary component of the required reply.

A copy of the Notice of Allowability including the drawing requirement is enclosed for petitioner's reference.

The Commissioner may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Commissioner to be "unavoidable".³ Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.⁴

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a).⁵ Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.⁵

The showing of record suggests that the failure to respond to the Notices resulted from the failure of petitioner's former counsel

³ 35 U.S.C. § 133.

⁴ In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

⁵ Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

as well as petitioner herself. With regard to Breaux's suspension from practice before the USPTO, petitioner must provide evidence of the date Breaux ceased practice before the USPTO. In particular, petitioner must explain whether Breaux was representing her at the time the Notice was mailed and whether Breaux was permitted to practice before the USPTO as of the date the Notices were mailed, and for a reasonable time thereafter. In this regard, petitioner should send a letter by certified mail to Breaux, (and perhaps to Keisel, as the court-appointed curator of Breaux's files), stating that the Office is requesting their assistance in determining whether the delay in responding to the why the Notices mailed on 4 March, 2003, was unavoidable. A copy of the letter, and any response received thereto, should be included in any renewed petition.

As stated previously, the showing of record is that, notwithstanding his later suspension from practice, Breaux was petitioner's validly appointed attorney and was empowered to represent petitioner before the USPTO at the time the Notices were mailed.

While petition allegedly chose to rely upon Breaux, such reliance per se does not provide petitioner with a showing of unavoidable delay within the meaning of 37 CFR 1.378(b) and 35 USC 41(c).⁶ Rather, such reliance merely shifts the focus of the inquiry from petitioner to whether Breaux acted reasonably and prudently.⁷ Nevertheless, petitioner is bound by any errors that may have been committed by Breaux.⁸

The U.S. Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions.⁹ Specifically, petitioner's delay caused by the mistakes or negligence of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 U.S.C. § 133.¹⁰

A delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP

⁶ See California Med. Prod. v. Technol Med. Prod., 921 F. Supp. 1219, 1259 (D. Del. 1995).

⁷ Id.

⁸ California, *supra*.

⁹ Link v. Wabash, 370 U.S. 626, 633-34 (1962).

¹⁰ Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N. D. Ind. 1987); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (Comm'r Pat. 1891).

does not constitute an "unavoidable" delay.¹¹ A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to: (1) the applicant's reliance upon oral advice from Office employees; or (2) the Office's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action.¹²

Finally, petitioner is reminded that the U.S. Patent and Trademark Office is not the proper forum for resolving a dispute between petitioner and petitioner's representative.¹³

In summary, the showing of record is that the abandonment resulted from a mistake on the part of petitioner's counsel in failing to timely file a reply rather than as a result of unavoidable delay. As the showing presented is insufficient to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a).

More importantly, petitioner must explain the long period of delay between the date of her receipt of the file and the date she took action which resulted in learning that the application was abandoned. In particular, petitioner allowed over three (3) years to elapse between learning that Breaux was no longer authorized to practice and obtaining the file from Kiesel on 5 April, 2004, and contacting attorney Nagle in May, 2007. Petitioner has not shown whether any other steps were taken during the intervening time to inquire about the status of the application or whether any efforts were made to continue prosecution.

Further to this point, with respect to petitioner's statement that she "was not aware that any action was necessary until Mr. Nagle reviewed the prosecution history of my application" the showing of record is that petitioner chose to prosecute the application *pro se* from 5 April, 2004, until May, 2007. Petitioner was not forced, but rather made a conscious decision to prosecute the application *pro se*, and therefore must be held accountable for her actions, or lack thereof, before the Office. There are numerous resources available to petitioner, as to the

¹¹ Id.

¹² See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985); see also In re Colombo, Inc., 33 USPQ2d 1530, 1532 (Comm'r Pat. 1994) (while the Office attempts to notify applicants of deficiencies in their responses in a manner permitting a timely correction, the Office has no obligation to notify parties of deficiencies in their responses in a manner permitting a timely correction).

¹³ Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995).

others who have chosen this path of prosecution, to obtain the necessary information to prosecute the application before the Office.

The showing of record, therefore, particularly with respect to the extended period between 5 April, 2004, and May, 2007, the date of the filing of the present petition, is that rather than unavoidable delay, there was a lack of diligence on the part of petitioner. Specifically, it appears that petitioner was preoccupied with other matters during this period. Petitioner's preoccupation with other matters which took precedence over prosecution of the above-identified application does not constitute unavoidable delay.¹⁴

A delay resulting from a lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP does not constitute an "unavoidable" delay.¹⁵ As the showing of record does not rise to the level of unavoidable delay, the petition will be dismissed.

In summary, rather than unavoidable delay, the showing of record is that petitioner failed to take adequate precautions to ensure that a response to the Notices mailed on 4 March, 2003, was timely filed, or that a petition to revive the application or withdraw the holding of abandonment was timely filed. As petitioner has not shown that she exercised the standard of care observed by a reasonable person in the conduct of his or her most important business, the petition will be dismissed.¹⁶

As the showing of record is insufficient to satisfy the requirements of a grantable petition under 37 CFR 1.137(a), the petition will be dismissed.

ALTERNATIVE VENUE

Petitioner may wish to consider filing a renewed petition under 37 CFR 1.137(b), which now provides that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A

¹⁴ See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

¹⁵ See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ 1130, 1132 (N.D. Ind. 1987), Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

¹⁶ See note 7, supra.

grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after 8 June, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

The filing of a petition under the unintentional standard cannot be intentionally delayed and therefore should be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

Should petitioners decide to file a petition under 37 CFR 1.137(b), the additional petition fee due would be \$750.00 for a small entity.

A copy of the form for filing a petition under 37 CFR 1.137(b) to revive an application unintentionally abandoned is enclosed herewith for petitioners' convenience.

Receipt of the power of attorney and change of correspondence address is acknowledged.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3231.



Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

Enclosure: Notice of Allowability mailed 4 March, 2003
Form PTO/SB/64
Privacy Act Statement
Fee Schedule